Appl. No.: 09/658,612 Amdt. dated: April 19, 2004

Reply to Office Action of January 30, 2004

REMARKS/ARGUMENTS

These Remarks are in reply to the Office Action mailed January 30, 2004. No fee is due for

the addition of any new claims.

Claims 1-6 were pending in the Application prior to the outstanding Office Action. In the

Office Action, the Examiner rejected Claims 1-6.

I. Summary of Office Action.

Claim 1 was rejected under 35 U.S.C. 102(b) as being anticipated by Katz, U.S. Patent No.

4,834,551.

Claims 2-3 were rejected under 35 U.S.C. 103 over Katz in view of Inoue, U.S. Patent No.

6,332,024 or Cannon, U.S. Patent No. 6,393,272.

Claim 4 was rejected under 35 U.S.C. 103 over Katz in view of Grossman, U.S. Patent No.

6,122,346 or Satio, U.S. Patent No. 6,526,263.

II. Summary of Applicants Response

Applicants respectfully request reconsideration of the Examiner's rejections.

III. Response to Objections and Rejections

Claim 1 was rejected under 35 U.S.C. 102(a). Applicants respectfully request reconsideration

of the rejection. Claim 1 recites:

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A system for a telephone, comprising:

a mechanical device associated with a conversation element; (a)

a memory, coupled to the mechanical device, for storing an internal conversation (b) element representing an audible utterance for a remote listener in an ongoing

conversation; and

(c) a processor, coupled to the memory and the mechanical device, for generating the

audible utterance in response to a user interaction with the mechanical device and the

conversation element.

The claimed invention comprises a system for a telephone that generates audible utterances

for a remote listener in an ongoing conversation. Applicants respectfully submit that Katz is

deficient of the features of the claimed invention.

The Examiner, in rejecting claim 1 states in his rejection that "Katz teaches a call holding

alerting system....which can place an ongoing conversation in a hold mode and generate a message

that can be relayed to a remote listener". Applicants respectfully suggest that this reading of Katz is

incorrect. Katz discloses a system in which the held party, not the hold-initiating party can transmit

a continually running message to indicate that a predetermined DTMF tone is needed to deactivate

the recording, thus allowing the hold-initiating party to notify the held party that he is ready to

resume the conversation(col. 1. ll 35-65)

Katz does not teach an "element representing an audible utterance for a remote listener in

an ongoing conversation." Rather, Katz teaches an automatically cycling message that is started by

the held party after the held party is put on hold.(col.2 11. 36-40)

Given that there is no interaction happening at the time of message transmission in the system of

Katz, there is no "ongoing conversation" for which the message element is a part. The message of

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Katz is not transmitted in response to a statement by a remote listener or intended to invoke a

response and is thus not part of any manner of conversation, let alone an "ongoing conversation".

The alternative embodiments disclosed in Katz, which discuss the transmission of messages to

absent parties similarly fail to teach the features of the claimed invention.

Thus, in light of the fact that the message transmission in Katz occurs after a hold period

has begun and that the message that is transmitted is not configured to respond to a statement by

another party or elicit a response by another party, Applicants submit that Katz cannot be

reasonably interpreted to teach a conversation element configured to be transmitted to remote

listener as part of an ongoing conversation.

Regarding claims 2-6, neither Inoue, Satio, Grossman, or Cannon cure the deficiencies of

Katz. Thus claims 2-6, which contain the patently distinguishable subject matter of claim 1, are

likewise patentably distinguishable over the prior art.

IV. Conclusion

The references cited by the Examiner but not relied upon have been reviewed, but are not

believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the

subject patent application should be allowable, and a Notice of Allowance is requested. The

Examiner is respectfully requested to telephone the undersigned if he can assist in any way in

expediting issuance of a patent.

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The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: <u>April 19</u>,2004 By: ___

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